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Supreme Court of the United States

OCTOBER TERM, A. D. 1942.

No. 397

GENERAL PORCELAIN ENAMELING AND MANUFACTURING COMPANY,

Petitioner,

vs.

THE CERAMIC PROCESS COMPANY,

Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

EDMUND P. WOOD,
TRUMAN A. HERRON,
Counsel for Respondent.

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History of the Litigation.

This is a conventional suit for patent infringement. No industry questions are involved. No suits of any kind are pending on the same patent against other defendants and none are contemplated. The patent in suit expired almost a year ago and the injunction issued by the District Court long has been dissolved.

All five of the judges who have passed on the Scott patent have arrived at exactly the same conclusions with respect to it. In an earlier suit against another defendant the patent was held valid and infringed by Judge Robert R. Nevin of the United States District Court for the Southern District of Ohio. Judge Nevin rendered a careful and ex-

haustive opinion which is reported in 28 F. Supp. 794. An appeal was taken from this decision but was dismissed shortly before the hearing in the Sixth Circuit Court of Appeals. In the present case Judge Philip L. Sullivan, the trial judge, took the case under advisement and several weeks later rendered the brief oral opinion which is reported in the Record, page 165. The Circuit Court of Appeals for the Seventh Circuit speaking through Judge Sparks rendered an unanimous opinion affirming the decision of Judge Sullivan. This opinion which appears in the Record, pages 206-211 inclusive, has been reported in 129 F. (2d) 803.

With the exception of the case of *Morton Salt Co.* v. *Suppiger*, 314 U. S. 488, which deals with a principle of law which petitioner has never before attempted to apply to the facts of this case and which as we will subsequently show has no application, all of the cases on which petitioner is now relying as a basis for invoking the jurisdiction of this court were carefully considered by the Circuit Court of Appeals. There is no conflict between the decisions of this court relied on by petitioner and the decision of the Seventh Circuit Court of Appeals in the present case.

Nature of Patent in Suit.

The description of the invention of the patent in suit contained in the petition is rather misleading and difficult to follow. For the purpose of clarification we quote the far more accurate and intelligible description contained in the opinion of Judge Sparks (R. p. 207):

> "The process of the patent before us involves generally a series of steps comprising the preparation of a mix of frit (powdered glass), coloring oxide and an oily fluid (called a 'carrier'), forcing the mix through the mesh of a screen stencil

> onto a vitreous surface to be decorated, and then exposing the design and surface to an enamel-fusing temperature. The process provides for the application of a decorative layer of glass to a glass surface so that the design or decorative layer becomes integral with the surface and fully resistant to any form of exposure which can be endured by the surface itself. The equipment necessary to practice the process forms no part of the invention. The screen stencil usually is fashioned from silk or wire mesh having pervious and impervious portions. The impervious outline which forms the design may be placed on the mesh in any one of a number of different ways. The instrumentality used to force the mix through the stencil is usually a rubber scraper called a 'squeegee'."

Claim 2 of the Reissue which is representative, reads:

> "Method of producing designs upon a vitreous surface which comprises placing a fine mesh stencil onto the vitreous surface and taking a pasty composition containing a finely ground enamel 'frit' and an oily carrier and forcing said composition through the mesh portion of the stencil onto the vitreous surface, whereby the composition will be applied to the design portion of the surface in subdivided form, and finally heating the article to an enamel-fusing temperature."

This process is one which has gone into wide and successful commercial use in both the porcelain enamel field and the glass field. As Judge Nevin said, 28 F. Supp. 794 (797):

> "the invention of the Scotts to an appreciable extent revolutionized ceramic decoration. It has in fact virtually created new lines of business, such as the decorated tumblers for the chain store and the decorated food package ware. It has 'advanced the art substantially'."

The Issues Presented by the Petition for Certiorari.

Possibly because of the mark which the Scott patent has made on industry, at no time has the petitioner made any serious effort to question the presence of invention. Only one prior art patent has ever been relied on to negative novelty or invention and that is the Beck et al. patent (R. p. 192) which was fully considered by the Patent Office before the claims of the Scott patent were allowed. It was also considered carefully in both of the reported opinions.

With respect to infringement, generally, it is not seriously questioned but that the defendant's method comes under any ordinary interpretation of the language of the patent claims. The defendant's process was described in interrogatories answered by one of its officers, as follows: (R. p. 4)

> "Powdered ceramic colors containing oxide or coloring material and frit are obtained from the manufacturer in powdered form. In applying this coloring material to the porcelain enamel surface, the powder is mixed with a carrier and then forced through the interstices of a screen by means of a squeegee and is then fused onto the porcelain enamel surface."

If this interrogatory answer is compared with Claim 2 of the patent, quoted on p. 3 herein, it will be noted that prior to trial the infringement issue was narrowed to a point where the defendant denied only that its combined material was "pasty" and that it was applied to the vitreous surface "in subdivided form". These contentions present issues of fact which were found against the defendant by the trial judge after he had witnessed a physical demonstration of the defendant's process and by the Circuit Court of Appeals which had before it specimens of the equipment

and materials used by the petitioner including specimen decorated signs (Exhibits 19 and 32) which clearly show the "subdivided form" called for by the claim.

Accordingly, in its petition to this court the petitioner has been compelled to limit its argument to the three contentions advanced in its petition and brief. These are:

(1) That the Reissue is invalid because it is for a different invention than that called for by the original application,
(2) That there is no infringement because of an enforced file wrapper interpretation of the word "pasty", and
(3) Because of the existence of certain contractual relationships with respect to the patent which are asserted to bar respondent's rights to enforce its patent.

This last issue has never been raised nor even suggested prior to the filing of the petition to this court.

We will reply to each of the petitioner's contentions in order.

The Invention Described In The Reissue Patent Is The Same As That Described In The Application Originally Filed.

The petitioner's contention on this point seems to be that the original application did not specifically state that when the decorating material was forced through the stencil mesh onto the vitreous surface it would be applied in a finely divided condition or "subdivided form". A statement describing this result was added to the application during prosecution of the original patent (R. p. 143-4) and was retained in the reissue. However, the original application, as first filed, clearly describes "working up the powdered quartz-like enamel or 'enamel frit' and oxide

mixture into a suitable pasty mass" (R. p. 133) "and pressing it (the pasty mass) through the meshes of the stencil by means of a squeegee". (R. p. 134)

Original Claim 2 (R. p. 135-6) is representative of the claims as filed. It reads as follows:

> "A method of producing vitreous enamel metal signs and other decorative articles comprising placing a stencil composed of meshed material having permeable and impermeable portions corresponding to the letter or design to be produced upon a vitreous enamel surface, pressing a finely ground vitreous enamel paste through the permeable portions of a stencil and removing the stencil, and finally heating the product to an enamel fusing temperature."

The only difference between this claim and Claim 2 of the reissue patent in suit is that the latter specifies the materials which go to make up the "finely ground vitreous enamel paste" and includes the functional statement that the material is applied to the surface to be decorated "in subdivided form."

Obviously, if the screen stencil is placed on the vitreous surface and a pasty material is forced through the permeable portions of the screen, the resulting design is bound to be applied to the surface in subdivided form because the material is subdivided by the screen mesh. This is all that this language means.

At the trial in the District Court petitioner's witness who conducted the demonstration of its process admitted that during the demonstration the design was "subdivided" by the screen mesh (R. p. 58).

The subdivided form of the design is merely an advantage which is inherent in the process described in the application and claims as originally filed. It is not a new or additional

step in the process. In the whole history of the prosecution of the application and reissue, no amendment that was ever filed changed in any way any single step of the process nor any item of the materials and equipment used in its practice from those specified in the application as first filed. The method steps of Claim 2 of the reissue patent are exactly the same as the method steps of Claim 2 of the application as originally filed.

In the case of *United States Industrial Chemicals, Inc.* v. *Carbide and Carbon Chemicals Corp.*, 315 U. S. 668, which is relied on by the petitioner on this phase of the case, there was a divergence between the original patent and the reissue. The reissue plainly omitted a step in the process which was described and claimed as essential in the original patent. Where the original patent in both specification and claims treated the introduction of water as a necessary step in the process, in the reissue this introduction was made merely permissive. Obviously, this change produced an entirely different invention from that described in the original patent. The reissue involved in the case cited was a very broadening one while in contrast every step in the prosecution of the Scott patent involved in the present case has been narrowing. The original Scott application was narrowed by amendments and the original patent was definitely narrowed by the reissue.

In summary, the reissue of the Scott patent did not omit any of the steps or elements, materials or equipment described in the original patent or even in the original application. The amendments to the original application were simply a recital of an obvious result of the use of the steps of the process as originally described. The reissue simply added material of an explanatory nature which admittedly had the effect of narrowing the scope of the patent.

There Is No File Wrapper Estoppel.

On this point, it seems to be the petitioner's contention that the history of the prosecution of the patent requires a limitation of the meaning of the word "pasty" to a material which is so thick that it will not run together after it has been pressed through the screen. The same argument was vigorously urged before the Circuit Court of Appeals. It is purely a factual argument.

The word "pasty" was used in the original Scott application (R. p. 133) to describe the consistency of the decorating mixture, the ingredients and proportions of which were carefully specified. The word also appeared in original Claims 2, 4 and 5 (R. p. 136-7). It is a word that was voluntarily selected by the inventors; not one the use of which was enforced by the Patent Office. Not a word nor a phrase in the original specification indicated that the Scotts intended to limit themselves to the use of a mix of any exact consistency. By use of the word "pasty" they undoubtedly had in mind a material of a viscosity which would give good results in their process, that is, a material which could be used in cooperation with a screen stencil in such a way that it would not run off the edges of the design after the stencil had been removed and would form, and preferably retain, a corrugated and subdivided surface in the body of the design.

The word "pasty" is an ordinary word in common usage and it accurately describes the consistency of the Scotts material and the petitioner's material as well. Had the inventors or the Patent Office intended some unusual or limited meaning for the word, surely this would have been brought out in the original application or in the claims found allowable. It was established by the evidence that, after it has been mixed, the petitioner's material becomes

progressively thicker and dries out completely within an hour (R. p. 49). Surely the Scott patent cannot be interpreted as covering the use of a material at a given moment but not covering its use ten minutes earlier.

The case of *Schriber-Schroth Company* v. *Cleveland Trust Company*, 305 U. S. 47, relied on by petitioner, is an excellent example of conventional file wrapper estoppel. In that case, the patentee tried to insert into the specification at a late date in the history of the prosecution of the application a statement as to an asserted characteristic of an element in the patented device which was exactly contrary to the characteristics of the element as described in the application as filed. Where the original application described the piston webs as "extremely rigid", the inventor sought by amendment to make them "flexible". It was properly held that the patent could not be stretched to hold as an infringement a structure having flexible webs. However, there is no analogy whatsoever between the facts of the *Schriber-Schroth* case and the facts of the present case. In the present case, the inventors described their preferred material as "pasty" from the beginning of the prosecution of the application to the end. They described the exact ingredients which they used and limited their claims to these ingredients or the equivalents. The petitioner uses close equivalents of the exact materials. In the opinion of every court which has observed petitioner's decorating material, it is "pasty" within the meaning of the inventors and their patent.

There Has Been Nothing Improper In the Licensing of the Scott Patent.

The suggestion, at this late date in the proceedings, that the decision of this court in *Morton Salt Company* v. *Suppiger,* 314 U. S. 488, has some application to the facts of this case illustrates the length to which petitioner has been forced in its attempt to justify its position. The facts are that respondent is the owner of some four or five patents relating to equipment such as screens and tables useful in the practice of the Scott process. These patents are enumerated in Exhibits 39 and 40 but they do not appear in the Record filed with this court. Along with the Scott patent, these equipment patents have been licensed rather widely and on more or less uniform terms to those interested in decorating vitreous surfaces by the Scott process. From the point of view of the public, this type of licensing arrangement has always been considered the most beneficial way of commercializing a patent or a group of patents. There has been no regulation of prices and no improper control of unpatented supplies or materials. There is no evidence whatsoever to support the petitioner's assertion that respondent's licensees are still bound by their contracts even though the Scott patent has expired. Obviously, they are not bound unless they are still using the patented equipment.

The relationship between respondent and Solar Laboratories referred to by petitioner is simply that each company at one time held an exclusive license under the Scott patent but in different fields. The two companies are now and always have been completely separate and distinct. There is not a single common director nor a single common stockholder. The licenses granted by Solar Laboratories which are set forth in the Record pp. 113-127, inclusive, were in-

troduced into evidence by respondent for the purpose of showing the commercial success of the Scott process in the glass field and they were received by the Court for this purpose. Although petitioner does not cite a single reason or authority which has the slightest bearing on the legality of the licenses of Solar Laboratories, the whole matter is completely immaterial because Solar Laboratories is not a party to this case and, except as stated, has no connection of any sort with respondent. Apparently, it is not contended that there is anything improper in respondent's licenses, and petitioner has not even taken the trouble to submit them to this court.

Conclusion.

Summarizing, the respondent submits that there is no issue here involved which in any way justifies the consideration of this case by this court. It is purely a private controversy. The decision has affected and will affect no one but the parties themselves. The issues are almost exclusively factual issues which have been found against petitioner emphatically by the trial court and unanimously by the reviewing court. No unusual or controversial questions of law are involved. The legal issues that are involved have been correctly decided. There is no conflict of any sort between the decision of the Circuit Court of Appeals in this case and the decisions of this court. It is submitted that the petition should be denied.

Respectfully,

EDMUND P. WOOD,
TRUMAN A. HERRON,
Counsel for Respondent.